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In re Application of:	:	
UNDERBRINK et al.	:	DECISION ON RENEWED
Application No.: 10/570,833	:	PETITION
PCT Application No: PCT/US2004/028926	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 02 September 2004	:	
Priority Date: 02 September 2003	:	
Attorney's Docket No.: SIRF-113US	:	
For: SIGNAL PROCESSING SYSTEM FOR	:	
SATELLITE POSITIONING SIGNALS	:	

This is in response to the "Renewed Petition Under 37 C.F.R. §1.137(b)," filed 05 October 2009.

BACKGROUND

The present application became abandoned for failure to timely file a proper reply to the "Notification of Defective Response," mailed 29 May 2008, requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b).

In a decision mailed 03 June 2009, applicants' request to correct inventorship under 37 CFR 1.497(d) and petition to revive under 37 CFR 1.137(b) were dismissed. The petition to revive was dismissed for failure to provide the required reply. Specifically, the decision noted that a grantable request under 37 CFR 1.497(d) was not filed in that adequate written consent of the assignee was not provided. In addition, the decision noted that applicants failed to correct the composite declaration defect noted in the 08 November 2007 decision vis-à-vis inventors Underbrink, Falk, Gronemeyer and Protic.

On 25 September 2009, applicants filed a statement under 37 CFR 3.73(b).

On 05 October 2009, applicants filed the renewed petition under 37 CFR 1.137(b); renewed request under 37 CFR 1.497(d), and complete executed declarations by the inventors.

DISCUSSION

I. Request under 37 CFR 1.497(d)

A request under 37 CFR 1.497(d) to accept an oath or declaration changing inventorship must include:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

As indicated in the decision mailed 03 June 2009, items (1)-(2) have been complied with, and item (4) is not applicable.

With respect to item (3), applicants have not provided proper written consent of the assignee and have not complied with the requirements of 37 CFR 3.73(b).

The “written consent of the assignee” requirement is discussed in MPEP § 201.03 (which generally applies to U.S. national phase applications; see MPEP §1893.01(e)). MPEP §201.03 states, in part:

The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent. However, if it appears in another paper of record, e.g., small entity assertion, it is also acceptable. Further, the assignee must establish its ownership of the application in accordance with 37 CFR 3.73. MPEP § 324.

While applicants have submitted a statement under 37 CFR 3.73(b) to establish ownership by SiRF Technology, Inc., written consent of the assignee for the change in inventorship has not been submitted.

In addition, the statement under 37 CFR 3.73(b) is insufficient. The statement refers only to the assignment recorded at Reel/Frame 091103/0984. It fails to reflect a later filed assignment by an additional inventor.

II. Petition under 37 CFR 1.137(b)

Pursuant to 37 CFR 1.137(b), a petition to revive the present application based upon unintentional abandonment must include: (1) the proper reply, unless previously filed; (2) the petition fee under 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required

reply from the due date for the reply until the filing of a grantable petition was unintentional; and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

As indicated in the 03 June 2009 decision, petitioners previously complied with items (2)-(4).

For reasons indicated in § I above, petitioners have not provided the requisite reply.

CONCLUSION

For the above reasons, the petition under 37 CFR 1.137(b) and request under 37 CFR 1.497(d) are **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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